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Correspondence

ATTN: Art Unit 1732 / Examiner Mathieu D. Vargot

CLIENT NAME/NUMBER: 18554F

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FROM: Enrique G. Estevez **DATE: August 30, 2004**

NUMBER OF PAGES (INCLUDING COVER SHEET): 5

COMMENTS/INSTRUCTIONS: Attached is a Response to Restriction
Requirement for 09/938,288 for Method of Forming a Compact Disc

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Gerald A. Pierson

Serial No. 09/938,288

Filing Date: August 23, 2001

For: Methods of Forming A Compact Disc

Examiner: Mathieu D. Vargot

Art Unit: 1732

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Alexandria, VA 22313-1450

Sir:

In response to the Office Action mailed on August 11, 2004, please enter the election in the above application, as follows.

Election of Claims

Applicant, with traverse, elects the claims in Group II for further prosecution at this time, that is, Claims 42 and 43. Applicant, however, respectfully requests the Examiner's reconsideration and withdrawal of the restriction as to Groups I and II for the reasons set forth below.

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In the Claims:

Please cancel claims 35-41 without prejudice. The claims remaining in the application are set forth below in a complete listing. There are no claim amendments made at this time.

1-41.(cancelled)

42.(previously presented) A method of forming an optical compact disc, the method comprising:

molding a compact disc having a pattern of digital data encoded on a surface bounded by first and second pairs of spaced-apart outer side peripheries defining outer boundaries of at least portions of the disc, each of the first pair of spaced-apart outer side peripheries arcuately extending between each of the second pair of spaced-apart outer side peripheries extending substantially linearly between each of the first pair of spaced-apart outer peripheries.

43.(original) A method as defined in Claim 42, further comprising positioning an opening in a medial portion of the compact disc, wherein each of the arcuately-extending first pair of spaced-apart outer side peripheries of the portion of the disc are centered about an axis extending through the medial opening and substantially perpendicular to the linearly-extending second pair of spaced-apart outer side peripheries, and wherein a radius extending from a medial portion of the medial opening to each of the arcuately-extending first pair of spaced-apart outer side peripheries of the major elevational portion is less than 1.6 inches.

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REMARKS

In order to comply with the restriction requirement imposed in the Office action, Applicants have elected claims in Group II for further prosecution in this application. Applicants, however, respectfully disagree and traverse this requirement.

According to MPEP § 803, a restriction requirement is proper when 1) the inventions are independent or distinct as claimed, and 2) there is a serious burden on the examiner if restriction is not required. Applicants recognize that the Examiner has determined that the inventions are distinct from each other.

MPEP § 803 further requires an additional criterion for the proper imposition of a restriction. That is, the inventions must be independent or distinct and there must be a serious burden on the examiner if restriction is not required. This serious burden refers to a search burden.

Groups I and II are both classified in class 264, subclass 1.33. Accordingly, Applicants respectfully request that the Examiner exercise discretion and examine these two groups of claims together, as they both require a common search strategy in the same class/subclass. Therefore, it should represent no serious additional burden for the Office to examine all the claims of Groups I and II together in a single application. In fact, it would be much more efficient to examine these claims as part of this one application, rather than to require a divisional application for these two embodiments of the invention.

Conclusion

In view of the election, Applicants submit that these claims are patentable and respectfully request allowance of the application.

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If the further prosecution can be facilitated through a telephone conference between the Examiner and the undersigned, the Examiner is respectfully requested to telephone the undersigned.

Respectfully submitted,



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I hereby certify that this correspondence, addressed to Commissioner for Patents, Alexandria, VA 22313, is being filed with the United States Patent and Trademark Office by facsimile telecopier to its centralized fax number at 703-872-9306 to the attention of Mathieu D. Vargot, Art Unit 1732 this 30th day of August, 2004.


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